

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Joerg HAGER

Application No. 09/936,299

Group Art Unit: Unassigned

Filed: 12 September 2001

Examiner: Unassigned

For: COMPOSITIONS AND METHODS FOR GENETIC ANALYSIS

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS
UNDER 35 U.S.C. 371**

BOX PCT

Commissioner for Patents

Washington, D.C. 20231

Sir:

Applicants respectfully request review by the Examiner with regard to the Request for Sequence Listing in the Notification of Missing Requirement under 35 U.S.C. 371. Applicants point out that no sequence data appears in this application. The only sequences found, which do not meet the requirements, are: GATC (*see, e.g.*, page 19), which is too short to be included in a listing, and PERT (*see, e.g.*, page 28), which is an acronym.

Applicants respectfully request the Notice to Comply be withdrawn for the reasons stated above. It is believed that no fees are due however, if any further fees are due in connection with the filing of the attached papers, the Commissioner is authorized to charge any underpayment or credit any overpayment of fees to the deposit account of undersigned, no. 50-1067.

Respectfully submitted,

Date: 19 December 2001



Don J. Polto

Reg. No. 33,754

McKenna & Cuneo LLP
1900 K Street, NW
Washington, DC 20006
Telephone 202.496.7500
Facsimile 202.496.7756

FORM PTO 1396
(REV. 11 2000)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

ATTORNEY'S DOCKET NUMBER

24190.0004

TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)

09/936,299

INTERNATIONAL APPLICATION NO.

PCT/EP00/02053

INTERNATIONAL FILING DATE

09 March 2000

PRIORITY DATE CLAIMED

12 March 1999

TITLE OF INVENTION

COMPOSITIONS AND METHODS FOR GENETIC ANALYSIS

APPLICANT(S) FOR DO/EO/US

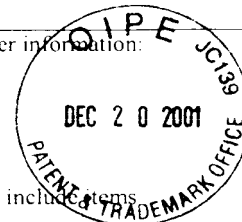
Joerg HAGER

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.
4. ☐ The U.S. has been elected by the expiration of 19 months from the priority date (Article 31).
5. ☐ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
 - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2))
 - a. ☐ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4)
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☐ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
10. ☐ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11 to 20 below concern document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A FIRST preliminary amendment.
14. ☐ A SECOND or SUBSEQUENT preliminary amendment.
15. ☐ A substitute specification.
16. ☐ A change of power of attorney and/or address letter.
17. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 35 U.S.C. 1.821-1.825.
18. ☐ A second copy of the published international application under 35 U.S.C. 154(d)(4).
19. ☐ A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
20. ☒ Other items or information: Request to Correct Priority Date; Response to Notification regarding Sequence Listing



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PCT/EP00/02053

24190.0004

21. ☐ The following fees are submitted:**BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(5)):**

Neither international preliminary examination fee (37 CFR 1.482)
nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO
and International Search Report not prepared by the EPO or JPO.....**\$1040.00**

International preliminary examination fee (37 CFR 1.482) not paid to
USPTO but International Search Report prepared by the EPO or JPO.....**\$890.00**

International preliminary examination fee (37 CFR 1.482) not paid to USPTO
but international search fee (37 CFR 1.445(a)(2)) paid to USPTO.....**\$740.00**

International preliminary examination fee (37 CFR 1.482) paid to USPTO
but all claims did not satisfy provisions of PCT Article 33(1)-(4).....**\$710.00**

International preliminary examination fee (37 CFR 1.482) paid to USPTO
and all claims satisfied provision of PCT Article 33(1)-(4).....**\$100.00**

ENTER APPROPRIATE BASIC FEE AMOUNT =

\$0.00

Surcharge of **\$130.00** for furnishing the oath or declaration later than ☐ 20 ☒ 30
months from the earliest claimed priority date (37 CFR 1.492(e)).

\$130.00

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total claims	=	0	x \$18.00	\$0.00	
Independent claims	=	0	x \$84.00	\$0.00	
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			+ \$280.00	\$0.00	
TOTAL OF ABOVE CALCULATIONS =				\$130.00	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2.					
SUBTOTAL =				\$65.00	
Processing fee of \$130.00 for furnishing the English translation later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date (37 CFR 1.492(f)).				\$0.00	
TOTAL NATIONAL FEE =				\$65.00	
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property +				\$0.00	
TOTAL FEES ENCLOSED =				\$65.00	
				Amount to be refunded:	\$
				charged:	\$

a. ☒ A check in the amount of \$ 65.00 to cover the above fees is enclosed.b. ☐ Please charge undersigned's Deposit Account No. 50-1067 in the amount of \$_____ to cover the above fees. A duplicate copy of this sheet is enclosed.c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-1067. A duplicate copy of this sheet is enclosed.d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. **Credit card information should not be included on this form.** Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

Don J. Pelto
McKenna & Cuneo, L.L.P.
1900 K Street, NW
Washington, DC 20006
Telephone: 202.496.7500
Facsimile: 202.496.7566

19 December 2001

SIGNATURE

Don J. Pelto

NAME

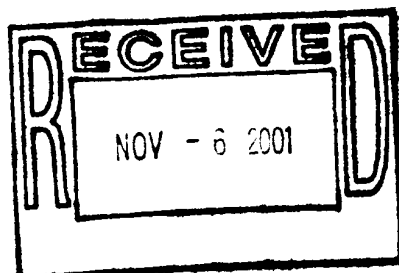
33,754

REGISTRATION NUMBER

x Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D C 20231 www.uspto.gov

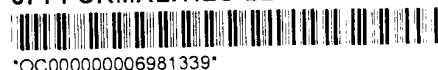
U.S. APPLICATION NUMBER NO	FIRST NAMED APPLICANT	ATTY DOCKET NO
09/936,299	Joerg Hager	24190.0004

Don J Peltó
McKenna & Cuneo
1900 K Street NW
Washington, DC 20006



INTERNATIONAL APPLICATION NO	
PCT/EP00/02053	
1A FILING DATE	PRIORITY DATE
03/09/2000	03/11/1999

CONFIRMATION NO. 4066
371 FORMALITIES LETTER



OC000000006981339

Date Mailed: 10/29/2001 *By mail to 29 December 2001*

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Indication of Small Entity Status
- Priority Document
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Preliminary Amendments
- Small Entity Statement

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$65 Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.
- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):
 - A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).

■ **APPLICANT MUST PROVIDE:**

- An initial or substitute computer readable form (CRF) of the "Sequence Listing."
 - A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).
- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:
 - For Rules Interpretation, call (703) 308-4216
 - To Purchase PatentIn Software, call (703) 306-2600
 - For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$65** for a Small Entity:

- **\$65** Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

VONDA M WALLACE

Telephone: (703) 305-3736

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO	INTERNATIONAL APPLICATION NO	ATTY DOCKET NO
09/936,299	PCT/EP00/02053	24190 0004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Joerg HAGER

Application No. 09/936,299

Group Art Unit: Unassigned

Filed: 12 September 2001

Examiner: Unassigned

For: COMPOSITIONS AND METHODS FOR GENETIC ANALYSIS

REQUEST TO CORRECT PRIORITY DATE

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully request that the Priority date listed on the Transmittal Letter to the U. S. Designated/Elected Office Concerning a Filing under 35 U.S.C. 371 and the Notification of Missing Requirements under 35 U.S.C. 371 in the U. S. Designated/Elected Office be corrected to reflect the correct priority date of 12 March 1999. Applicants attach a copy of Form PCT/IB/318, which reflects the corrected priority date. Applicants aver that this error was inadvertent.

It is believed that no fees are due; however, if any further fees are due in connection with the filing of the attached papers, the Commissioner is authorized to charge any underpayment or credit any overpayment of fees to the deposit account of undersigned, no. 50-1067.

Respectfully submitted,

Date: 19 December 2001



Don J. Pelto
Reg. No. 33,754

McKenna & Cuneo LLP
1900 K Street, NW
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Telephone 202.496.7500
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PATENT COOPERATION TREATY

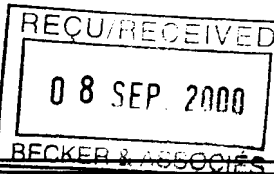
PCT

NOTIFICATION RELATING TO PRIORITY CLAIM

(PCT Rules 26bis.1 and 26bis.2 and
Administrative Instructions, Sections 402 and 409)

From the INTERNATIONAL BUREAU

To:

CABINET BECKER ET ASSOCIES
10, rue de Milan
F-75009 Paris
FRANCE

Date of mailing (day/month/year) 31 August 2000 (31.08.00)	
Applicant's or agent's file reference B0033WO	IMPORTANT NOTIFICATION
International application No. PCT/EP00/02053	International filing date (day/month/year) 09 March 2000 (09.03.00)
Applicant HAGER, Jörg	

The applicant is hereby **notified** of the following in respect of the priority claim(s) made in the international application.

1. ☒ **Correction of priority claim.** In accordance with the applicant's notice received on: 21 July 2000 (21.07.00), the following priority claim has been corrected to read as follows:

DE 12 March 1999 (12.03.99) 199 11 130.8

- ☐ even though the indication of the number of the earlier application is missing.
☐ even though the following indication in the priority claim is not the same as the corresponding indication appearing in the priority document:

2. ☐ **Addition of priority claim.** In accordance with the applicant's notice received on: , the following priority claim has been added:

- ☐ even though the indication of the number of the earlier application is missing.
☐ even though the following indication in the priority claim is not the same as the corresponding indication appearing in the priority document:

3. ☐ As a **result of the correction and/or addition** of (a) priority claim(s) under items 1 and/or 2, the (earliest) priority date is:

4. ☐ **Priority claim considered not to have been made.**

- ☐ The applicant failed to respond to the invitation under Rule 26bis.2(a) (Form PCT/IB/316) within the prescribed time limit.
☐ The applicant's notice was received after the expiration of the prescribed time limit under Rule 26bis.1(a).
☐ The applicant's notice failed to correct the priority claim so as to comply with the requirements of Rule 4.10.

The applicant may, before the technical preparations for international publication have been completed and subject to the payment of a fee, request the International Bureau to publish, together with the international application, information concerning the priority claim. See Rule 26bis.2(c) and the PCT Applicant's Guide, Volume I, Annex B2(IB).

5. ☐ In case where **multiple priorities** have been claimed, the above item(s) relate to the following priority claim(s):

6. A copy of this notification has been sent to the receiving Office and

- ☐ to the International Searching Authority (where the international search report has not yet been issued).
☒ the designated Offices (which have already been notified of the receipt of the record copy).

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Facsimile No. (41-22) 740.14.35

Authorized officer

Marie-José Devillard

Telephone No. (41-22) 338.83.38